

REMARKS

The Examiner's attention to the present application is noted with appreciation. The Applicant has carefully reviewed and considered the Final Office Action dated April 1, 2011. The following remarks are in response to the Final Office Action. The Examiner is respectfully requested to thoroughly consider Applicant's present response in its entirety.

I. Summary of Claim Status

Claims 34, 48, and 51 are pending. Claims 35-39 were canceled previously. Claims 40-47 are presently withdrawn. The present amendments to the claims cancel claims 49-50 as being directed to non-elected subject matter. No new matter is presented by the present claim amendments. Application respectfully requests entry of these amendments to the claims.

II. Amendments to the Specification

The first paragraph of the specification has been amended to correct the reference claiming the benefit of priority to prior-filed non-provisional and provisional applications.

III. Claim Rejections Under Judicially Created Doctrine of Double Patenting

Claims 34, 48, and 51 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent 7,740,847. Without admitting the propriety of the Examiner's rejection of Claims 34, 48, and 51 under the judicially created doctrine of obviousness-type double patenting and solely to expedite allowance of the present application, the Applicant has filed concurrently herewith a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) in order to obviate issues of judicially created double patenting in the present patent application. As required when a terminal disclaimer is signed by the assignee, a statement under 37 C.F.R. 3.73(b) is included below.

A. Identification of Person Making This Disclaimer

I, Robert L. Sharp, am employed by Eli Lilly and Company, and I am an attorney of record in the above-identified patent application. In that capacity, I am authorized to sign this disclaimer on behalf of Eli Lilly and Company.

B. Identity of Assignee

I hereby verify that the assignee owning all of the interest in this application is:

Applied Molecular Evolution, Inc.

3520 Dunhill Street

San Diego, CA 92121

Applied Molecular Evolution, Inc. is a wholly-owned subsidiary of Eli Lilly and Company (an Indiana corporation with a principal place of business at Lilly Corporate Center, Indianapolis, Indiana 46285).

C. Recordal of Assignment in PTO

The assignment was recorded on April 13, 2005, Reel 017887, Frame 0061.

D. Extent of Interest

The extent of Applied Molecular Evolution, Inc.'s interest is in the whole of this invention.

E. Disclaimer

I hereby disclaim, except as provided below, the terminal part of the statutory term of any patent granted on this application, which would extend beyond the expiration date of the full statutory term of:

United States Patent No. 7,740,847 and hereby agree that any patent granted on this application shall be enforceable only for and during such period that the legal title to the patent shall be the same as the legal title to United States Patent No 7,740,847.

I do not disclaim any terminal part of any patent granted on this application prior to the expiration date of the full statutory term of United States Patent No. 7,740,847 in the event that it

later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims canceled by a reexamination certificate, or is otherwise terminated prior to expiration of its full statutory term other than as presently shortened by any terminal disclaimer.

V. Claim rejections under 35 U.S.C. § 102(a)

Claims 34, 48, and 51 stand rejected under 35 U.S.C. 102(a) as allegedly being anticipated by the Business Wire reference. The Applicant respectfully traverses this rejection.

As discussed at length in the Applicant's response to the First Office Action (dated September 18, 2008), which also contained a rejection of the claims under 35 U.S.C. 102(a) as allegedly being anticipated by the Business Wire reference, the Business Wire is not an anticipatory reference under 35 U.S.C. 102(a) because it does not enable one of ordinary skill in the relevant art to make the presently claimed invention.

Briefly, it is incontrovertible that "[a]n anticipating reference must be enabling; that is, the description must be such that a person of ordinary skill in the field of the invention can practice the subject matter based on the reference, without undue experimentation." *Sanofi-Synthelabo v. Apotex, Inc.*, page 10 (Fed. Cir. 2008). A reference that is not enabling is not anticipating. *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003). The Wands factors are used to determine when experimentation is "undue": The "undue experimentation" component of that equation examines (1) the quantity of experimentation; (2) the amount of direction or guidance present; (3) the presence or absence of working examples; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability or unpredictability of the art; and (8) the breadth of the claims. *Impax Laboratories, Inc. v. Aventis Pharmaceuticals Inc.*, 545 F.3d 1312 (2008).

Upon consideration of the Wands factors with respect to the claimed subject matter of the instant application, it is clear that the Business Wire reference fails to enable one of ordinary skill

to make the presently claimed invention, i.e., a composition comprising a CD20 binding molecule comprising six CDRs each having a specific sequence. For instance, the Business Wire reference provides absolutely no direction or guidance to a skilled worker attempting to make the antibody disclosed therein as AME-133. Considering also that the rejected claims are drawn narrowly to compositions comprising a specific, sequence defined set of six CDRs, it is reasonable to conclude that undue experimentation would be required in order to make such a specifically claimed invention. In fact, the Business Wire reference merely names an anti-CD20 antibody, AME-133, that exhibits the functional attributes of greater affinity and potency, *in vitro*, as compared to Rituxan. By not disclosing the amino acid sequence of the antibody or providing any reference to a publicly available deposit of the antibody, the Business Wire reference fails to teach a person of ordinary skill in the highly unpredictable field of the present invention how to make the disclosed antibody without undue experimentation. In other words, even with knowledge of the Business Wire disclosure a person of ordinary skill in the field of the present invention could not practice the claimed subject matter for want of information regarding the antibody sequence(s) or a publicly available source of the composition without undue experimentation.

In the Final Office Action, the Examiner again failed to adequately support the 35 U.S.C. 102(a) rejection by a weighing of the Wands factors as required by the law (and as requested in the Applicant's prior response). Instead, the Examiner invokes, for the first time in the Final Office Action, reliance on the first paragraph of MPEP 2121 (see page 4 of the Final Office Action). However, the Examiner's reliance on the first paragraph of MPEP 2121 is also improper. More specifically, the first paragraph of MPEP 2121 reads:

When the reference relied on **expressly anticipates** or makes obvious **all of the elements of the claimed invention**, the reference is presumed to be operable. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980)(*emphasis added*).

Therefore, the language of MPEP 2121 is clear that the prior art reference shall be presumed to be operable only if the reference **expressly** anticipates all of the elements

of the claimed invention. That situation does not present itself in this case.

Importantly, the Examiner has repeatedly characterized the amino acid sequence of the claimed invention as an **inherent** element of the AME-133 antibody disclosed in the Business Wire reference (see page 3, paragraph 5 of the Final Office Action). Because the amino acid sequence is an element of the presently rejected claims, but is not **expressly** anticipated in the Business Wire reference, it is clearly improper for the Examiner to presume that the Business Wire reference enables the claimed invention. Thus, the Examiner has inappropriately maintained the rejection of claims 34, 48, and 51 under 35 U.S.C. 102(a) rejection as being anticipated under Business Wire.

Because the Examiner has not communicated any detail of an analysis of the Wands factors in order to support his conclusion that the cited Business Wire reference is an enabling prior art reference, the Applicants respectfully submit that the Examiner has not yet presented a prima facie case of anticipation of the claimed invention. Furthermore, as discussed above, the Examiner's citation of MPEP § 2121 offers no additional support for maintaining the prior rejection which was based merely upon conclusory and, otherwise, unsupported statements that the Business Wire reference is an anticipating reference under 35 U.S.C. 102(a).

In addition, or as an alternative, to the above arguments that the Business Wire reference does not qualify as enabling prior art reference against the present claims, Applicants have also filed concurrently herewith a 37 C.F.R. § 1.132 Declaration of Dr. Derrick Witcher, Ph.D., that clearly refutes the Examiner's unsupported assertion that the Business Wire reference is an enabling prior art reference against the presently claimed invention. In compliance with 37 CFR 1.116(e), the Declaration of Dr. Witcher is being submitted after final rejection, but before or on the same date of filing an appeal, upon the following showing of good and sufficient reasons why the affidavit is necessary and was not earlier presented. The affidavit is necessary because

the Examiner has improperly maintained a rejection under 35 U.S.C. 102(a) on the basis of a reference, the Business Wire reference, that does not qualify as anticipatory prior art against the claimed invention. Further, the affidavit was not presented earlier because the Applicant believed that the Examiner failed to properly shift the burden of such a showing of evidence to the Applicant. As discussed previously, the burden shifts to the Applicant to provide facts rebutting the presumption of operability once a reference is found that expressly anticipates or makes obvious all of the elements of the claimed invention. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980)(*emphasis added*). In the present case, the burden never shifted. However, without admitting the propriety of the Examiner's rejection of Claims 34, 48, and 51 under 35 U.S.C. 102(a) and solely to expedite allowance of the present application, Applicants have submitted the Declaration of Dr. Witcher herewith. Therefore, the Applicant submits that the Declaration is timely filed herewith in accordance with 37 CFR 1.116(e). Accordingly, the Applicant respectfully requests that the Examiner consider the arguments presented here as well as the Rule 132 Declaration of Dr. Witcher as it relates to the inoperability of the Business Wire reference, and withdraw the present rejection of claims 34, 48, and 51 under 35 U.S.C. 102(a).

VI. Fee Payment

Please charge the fee set forth in 37 C.F.R. 1.20(d), and charge any additional fees which may be required by this or any other related paper, or credit any overpayment to Deposit Account No. 05-0840 in the name of Eli Lilly and Company.

VII. In Conclusion

Applicant respectfully submits that the Terminal Disclaimer submitted herewith obviates the outstanding nonstatutory double patenting rejection. Additionally, Applicant respectfully

submits that the Declaration under 37 C.F.R. § 1.132 and/or the remarks submitted in this response is sufficient to overcome the outstanding rejection under 35 U.S.C. 102(a). Accordingly, the Applicant respectfully asserts that the present patent application is in condition for allowance. The Examiner is invited to contact the undersigned Attorney by telephone if there are any outstanding issues regarding this response or application, in order to attempt to resolve such issues, so that the claims may be allowed and issued without further delay.

Respectfully submitted,

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